

REMARKS

Applicant thanks the Office for the attention accorded the present Application in the February 22, 2006, Office Action. Claims 1-34 are pending in this application. Reconsideration in view of the following remarks is respectfully requested.

In that Action, claims 6, 10, 11, and 24 are rejected under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-12, 13 and 18-34 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ohata et al. (hereinafter Ohata) (US 6,469,978) in view of Sasaki (US Publication No. 2003/0033475). Claims 16 and 32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ohata in view of Sasaki further considered with Evans et al. (US 6,311,060). Claims 17 and 33 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ohata in view of Sasaki further considered with Official Notice. Claims 14 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ohata in view of Sasaki further considered with Nakatani et al. (Publication No. US 2002/0114614).

Applicant does not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed below. Further, Applicant reserves the right to pursue the full scope of the subject matter of the claims in a subsequent patent application that claims priority to the instant application.

Rejections under 35 U.S.C. § 112

In response to the rejections, claims 10 and 11 are amended to provide the antecedent basis. No new matter is therefore entered. Moreover, a reference document is provided as evidence that the function of "pre-gap" and "general application area" recited in claims 6 and 24 are both very common terms to those skilled in the art. Chapter III, p.15 of the provided document shows very clearly indicate the meaning and knowledge of the terms "pre-gap" and "general application area". In addition, "pre-gap" is defined in the CD-ROM standard (ISO/IEC 10149, also called "Yellow Book").

35 U.S.C. §103(a) rejections based on Ohata and Sasaki

The Office rejects claims 1-12, 13 and 18-34 under 35 U.S.C. §103(a) as being unpatentable over Ohata in view of Sasaki. Applicant traverses this rejection because Applicant submits that the Office has misinterpreted Ohata and Sasaki; Ohata, Sasaki, or their combination does not render the claims at issues obvious. The subject matter of claim 1 is to provide "a method for an optical recording device to background format an optical recording medium" (claim 1 of the present invention). As recited in claim 1, step (A) is "establishing a format recording table and storing the format recording table *in a memory in the optical recording device*, the format recording table comprising a plurality of recording units to record *whether the packets in the DMAs are recorded with digital data*" (claim 1 of the present invention) (emphasis added). Applicant's FIG. 3 shows an embodiment of the format recording table. In this embodiment, "every recording unit of the format recording table corresponds one by one to a packet in a DMA" (claim 8 of the present invention).

Whereas, Ohata does not teach a "format recording table" as does the claim 1. The table shown in FIG. 3 of Ohata is an embodiment of "a control data area for holding information needed to control recording/reproduction, such as the, *disk rotational speed and laser power required for recording or reproduction*" (column 7, lines 36-40) (emphasis added). The control data area also "contains physical format information, which includes the position information recorded to indicate the positions of the defect management areas DMA1 to DMA4 described above (column 7, lines 52-55) (emphasis added). The position information "includes the information of DMAs such as *the number, sizes, and start positions of DMAs*" (column 7, lines 58-60) (emphasis added). Furthermore, the control data area is "*provided at the radially innermost read-only area of a disk*" (column 7, lines 36-37) (emphasis added) instead of in a memory of an optical recording device. Accordingly, the table illustrated in FIG. 3 of Ohata is completely different from the format recording table in claim 1 of the present invention.

Moreover, Sasaki also fails to disclose Applicant's "format recording table." As described in Sasaki, when a partially formatted optical disk is inserted, the optical disk drive can resume background formatting and store dummy data only in the

unrecorded region by referring to the FDCB (paragraph 12). Specifically, the Formatting Disk Control Block (FDCB) is "in the lead-in region of the disk" (paragraph 10). In contrast, the format recording table in claim 1 of the present invention is established in a memory in the optical recording device.

Evans et al., Official Notice, or Nakatani et al. also fail to teach Applicant's "format recording table".

Even if the teachings of Ohata, Sasaki, Evans et al., Official Notice, and Nakatani et al. were combined, as suggested by the Examiner, the resultant combination does not suggest Applicant's "format recording table."

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be

non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Accordingly, Applicant submits that Ohata, Sasaki or their combination does not render the claim 1 obvious anticipate claim 1. Similarly, claim 19 also recites "a format recording table, which is stored in a memory in the optical recording device." The arguments set forth above regarding claim 1 also apply to claim 19. Applicant respectfully requests withdrawal of the rejections of claims 1 and 19.

Furthermore, Applicant submits that the dependent claims 2-18 and 20-34 not specifically addressed herein are allowable for the reasons discussed in pertinent portions associated with their independent claims 1 and 19, as well as for their own additional features. Accordingly, Applicant asserts that neither Ohata, Sasaki together, nor their combination with Evans et al., Official Notice, or Nakatani et al. renders claims 2-18 and 20-34 obvious. Applicant respectfully requests withdrawal of the rejections. Reconsideration of claims 1-34 is respectfully requested.

Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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